

REMARKS/ARGUMENTS

The Office Action mailed January 20, 2006, has been received and its contents carefully considered. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the foregoing amendments and the following remarks.

In the Office Action mailed January 20th, claims 1-3, 5-12 and 14-18 stand rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable.

No claims are added. Claims 11, 12, and 14 are herein cancelled. Claim 15 is amended. As such, claims 1-3, 5-10, and 15-18 remain pending.

CLAIM REJECTION – 35 U.S.C. § 103(a)

In the Office Action, Claims 1-3, 5-12 and 14-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 5,062,846 to Oh et al in view of U.S. Patent 5,501,693 to Gravener.

With respect to all pending claims and the surgical clips claimed therein, the Office Action admits that “Oh is silent with regards to the clip comprising complementary parts of an interlock mechanism formed along a portion of the vessel clamping inner surface of each of the first and second leg members; and wherein the interlock mechanism includes a ridge portion and a groove portion that are aligned when the clip is in the closed position.” However the Office Action states that it would have been obvious to one of ordinary skill in the art to “modify the clip of Oh to include the interlock mechanism taught by Gravener.” As part of the determination of obviousness, the Office Action on page 5 states that “the motivation to combine the references

comes directly from the Gravener reference itself.” However the Office Action does not provide the specific language or evidence in Gravener that constitutes the exact motivation to combine references. As such, Applicants respectfully assert that no such motivation to combine references exists in the Gravener reference. To the contrary, as explained in Applicants’ previous communication filed 31 October, 2005, the Gravener reference actually teaches away from the Oh reference, since Gravener is directed to deformable metal clips while Oh and the present invention are directed to re-openable and re-closable polymeric clips.

In addition, the Office Action further states “the Gravener reference is merely being used as a teaching reference for only interlocking mechanism and that the device of Oh is the one being modified with said interlocking mechanism.” In such case, Applicants respectfully assert that if Oh is the reference being modified, some motivation for such modification should come directly from Oh itself, and not directly from Gravener (as discussed above), especially if Gravener is only an ancillary reference being used to teach the stand-alone feature of an interlocking mechanism. Yet the Office Action also fails to explicitly point out which portion of Oh constitutes the motivation or suggestion to modify its teachings to arrive at the features of the claimed invention.

Applicants reiterate their argument submitted in their communication filed 31 October 2005 that a *prima facie* case of obviousness has not been established. Specifically, Applicants contend that there simply is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings to arrive at Applicants’ claimed invention.

The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 USPQ 459, 467 (1966) and

extensive ensuing precedent. When patentability turns on the question of obviousness, the search for and analysis of the prior art must include objective evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness, which is a question of fact drawing on the Graham factors. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008. Most importantly, “the factual inquiry whether to combine references must be thorough and searching.” *Id.* It must be based on objective evidence of record. *In re Lee*, 277 F.3d 1338, 1342-43, 61 USPQ2d 1430, 1433-4 (Fed. Cir. 2002).

The requirement that factual objective evidence showing a motivation or suggestion to combine references in a determination of obviousness is well established precedent and has been reinforced in myriad decisions, and cannot be dispensed with. *Id. See also, Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed.Cir.2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’ ”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed.Cir.1998). The need for specificity in a showing of factual, objective evidence of obviousness is also paramount. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir.2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed.Cir.1992) (the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

Not only must there be some factual, objective evidence of a motivation to combine references, such motivation must be desirable for obviousness to apply. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis added).

Applicants contend that the Office Action uses Applicants' own disclosure in making a finding of obviousness, or in determining that the references have some motivation or suggestion therein to be combined so as to arrive at Applicants' claimed invention. It is axiomatic however, that the motivation or suggestion to make the claimed combination must both be found in the prior art, and not based on the Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants contend that the Office Action has not set forth the requisite suggestion or motivation to combine the teachings of Oh and Gravener to arrive at the claimed invention, and instead has used impermissible hindsight, using the benefit of the disclosure of Applicants' invention, to conclude that it would have been obvious to one of ordinary skill in the art to "modify the clip of Oh to include the interlock mechanism taught by Gravener." Applicants contend that that the teachings of Oh do not provide any evidence of the desirability of combining the clip of Gravener with the clip of Oh.

Applicants contend that it would not have been obvious to one of ordinary skill in the art to combine the teachings of Oh and Gravener to arrive at the claimed invention. Furthermore, the Office Action has not presented any evidence of any suggestion or motivation in the references to combine the references to arrive at the claimed invention. Nor has the Office Action set forth any reasoning or evidence that knowledge generally available to one of ordinary skill in the art is sufficient to combine Oh and Gravener to arrive at the claimed invention.

Accordingly, Applicants respectfully assert that a *prima facie* case of obviousness has not been established. Therefore, claims 1, 8, and 15 are believed to be allowable and Applicants respectfully request that the rejection with regard to said claims be withdrawn.

In addition, with regard to amended Claim 15, a surgical clip is claimed having “a protruding ridge formed along a portion of the inner surface of one of the first and second legs; and...a groove formed along a portion of the other one of the first and second legs, the groove on one leg being in opposition to the protruding ridge on the other leg such that the ridge fits within the groove when the clip is in the closed position, wherein the protruding ridge and groove share a common plane of symmetry, a centerline of the protruding ridge being aligned with a centerline of the groove.” The symmetric interlocking arrangement of the ridge or ‘tongue 134’ and ‘groove 136’ in the present invention can be clearly seen from FIGS. 3 and 5 of the present invention. The imaginary centerlines drawn through the respective axes of symmetry of each of the ridge/tongue 134 and groove 136 in the present invention would be aligned with one another.

Gravener on the other hand, teaches away from the invention as claimed in Claim 15. In particular, Gravener teaches that “tongue and groove are asymmetrically disposed with respect to one another.” (Gravener, col. 1 last line to col. 2 first line). In a preferred embodiment of Gravener, “a first axial centerline extends through the elongate tongue and a second axial centerline extends through the elongate groove. The second axial centerline is offset from the first axial centerline.” (Gravener, col. 2, lines 5-8). In a further preferred embodiment, “the tongue includes first and second opposed lateral facets and the groove includes first and second opposed lateral walls. The tongue and groove are oriented such that, upon approximation of the first and second leg portions of the clip, a greater gap distance exists between the first lateral facet of the tongue and the first lateral wall of the groove than exists between the second lateral

facet of the tongue and the second lateral wall of the groove.” (Gravener, col. 2, lines 12-20)

None of these arrangements in Gravener constitute the invention as claimed in amended Claim 15. The reason for Gravener’s arrangement is “to enhance the occlusive characteristics of the clip by generating lateral and torsional components of clamping force.” (Gravener, col. 2, lines 22-24) Such lateral and torsional components of clamping force are not an objective of Applicants’ invention.

Gravener’s offset, asymmetric alignment of tongue and groove is best shown in FIGS. 5 and 6 therein:

“As best seen in FIG. 5, axial centerline "A" is laterally offset from axial centerline "B" a distance designated "d", resulting in the above-noted asymmetric orientation....Referring to FIG. 6, when the opposed leg portions 12 and 14 of surgical clip 10 are approximated to clamp body tissue 40 therebetween, a normal clamping force F_1 is exerted on the tissue. At such a time, tongue 36 and groove 38 interfit in such a manner as to create a gap G_1 between lateral facet 36a and lateral wall 38a, and a gap G_2 is created between lateral facet 36b and lateral wall 38b. As shown in FIG. 6, gap G_2 is greater than gap G_1 and, as a result, the clamped tissue will have the effect of inducing a lateral component of force F_2 as the tissue attempts to equalize the two gap distances.” (Gravener, col. 3, line 53 to col. 4, line 5).

Thus, Applicant’s invention as recited in amended Claim 15, having a symmetric tongue and groove that interlock together, would not provide the extra lateral and torsional clamping

force that is the clear objective and teaching of Gravener. Since Gravener teaches away from the invention as claimed in amended Claim 15, Applicants contend that a strong inference of non-obviousness should apply to said claim, and constitutes ample objective evidence as to why a skilled person would not be motivated to combine the references of Oh and Gravener to arrive at the present invention. Accordingly, at least with respect to amended Claim 15, Applicants contend that Gravener teaches away from any combination with Oh, such that a factual finding of obviousness should not apply, and that the rejection with respect to said claim should be withdrawn.

Dependent claims 2-3, 5-7, 9-10, and 16-18 each depend, directly or indirectly, from one or another of independent claims 1, 8, and 15. These claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. Furthermore, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since the independent claims are believed to nonobvious and therefore patentable, their dependent claims are therefore believed patentable. Therefore, applicants therefore respectfully request that the rejection with regard to claims 2-3, 5-7, 9-10, and 16-18 be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Docket No. 59474.21700
Application No. 10/763,439
Customer No. 30734

Patent

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59474.21700.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read 'ED', is written over a horizontal line.

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